

REMARKS

The final Office Action of September 9, 2004 has been received and reviewed. The Applicant wishes to thank the Examiner for the courtesies extended to the Applicant's representative, Luan Do, during the personal interview of December 29, 2004. The issues raised and discussed during the telephone interview are set forth below in the context of a rebuttal of the currently outstanding rejections of the claims.

Prior to this Office Action, claims 1-24 were pending in the application, of which claims 1, 20 and 24 are independent. By the above actions, independent claims 1, 3 and 20 have been amended, and new claims 25 and 26 have been added to further differentiate the features of independent claims 1 and 20 and new claims 25 and 26. Therefore, claims 1-26 are pending with claims 1, 20 and 24 being independent.

Prior to discussing the detailed Office Action of September 9, 2004, Applicant would like to summarize the previous Office Action and Applicant's amendment, which was considered as placing the claims in allowable condition by the Examiner. In the January 26th Office Action, claims 1-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Goldschmitt of (WO 96/24213 A1 - hereinafter Goldschmidt), in view of Bezos et al. (U.S. Patent No. 6,029,141 - hereinafter Bezos). In the telephonic interview of March 25, 2004, the Examiner acknowledged and agreed that the advertisement in Bezos is a hyperlinked document itself, whereas the embedded advertisement in the presently claimed invention can include a hyperlink. Accordingly, Applicant amended claims 1 and 20 in the Amendment mailed May 26, 2004 to add the language "wherein said at least one advertisement optionally includes a hyperlink" to further show distinction between hyperlink and a communication.

Further, as summarized and acknowledged by the Examiner in the Interview Summary dated March 30, 2004, the advertisement in Bezos is under control of a third party and not under the local control of the sending party. That is, a user or customer has no control of the display or promotion of the products offered by the merchant or

its associates. Accordingly, Applicant has added in the previous Amendment new dependent claim 23 and independent claim 24 directed to the feature wherein the pre-selected advertisement is under the local control of the sending party so as to be in accordance with the discussion during the interview and to further distinguish the presently claimed invention over Bezos.

Turning now to the detailed Office Action of September 9, 2004, the Examiner has reapplied Goldschmitt (WO 96/24223A1) in view of Bezos et al. (U.S. Patent No. 6,029,141 – hereafter Bezos) to claims 1-19 and 23-24 but with an interpretation of Bezos that is different than the interpretation in the Office Action of January 26, 2004 and the Interview Summary of March 25, 2004. This rejection is respectfully traversed at least for the reasons provided below.

In the Office Action of September 9, 2004, the Examiner states that “Bezos discloses embedding the advertisement within the communication and associating the pre-selected advertisement with said communication within the user-managed data processing system (i.e. can disseminate catalogs. . .e-mail newsletters. . .that include the associate’s reviews and/or recommendations on specific products sold by the merchant)”. In the interview of December 29, 2004, the Examiner clarified his position in contending that the “associate” of Bezos is equivalent to the sending party, and the “customer” of Bezos is equivalent to the recipient of Applicant’s presently claimed invention. Also, the Examiner stated in the interview of December 29, 2004 that the graphic icon hyperlink 600 in Fig. 6 of the Bezos reference is the advertisement, and that the “catalog” 120 includes a communication message 606 in Fig. 6 of Bezos. Hence, according to the Examiner, Fig. 6 of Bezos, in combination with the teaching of Goldschmitt, teaches, discloses or suggests Applicant’s claim 1, which previously included claimed steps of:

*initiating a communication from a data processing
system of a sending party;
associating at least one pre-selected
advertisement with said communication within the
data processing system of the sending party; and*

*transmitting said communication with said at least one advertisement embedded therein to the recipient,
wherein said at least one advertisement optionally includes a hyperlink.*

Again, Applicant respectfully submits that in Bezos, the referral hyperlink (600 or 608) is an essential component in a software system and method for enabling an Internet sales merchant (e.g., Amazon.com), to market and sell goods to “customers” in cooperation with Web sites or other network sites of respective business partners, referred to as “associates.” The referral hyperlink of Bezos includes a unique product ID, the unique store ID associated with a particular associate, and an optional associate commission ID from the URL data string represented by the referral hyperlink. The invention of Bezos, as interpreted by the Examiner, requires an interaction between the “customer”, the “associate” and the “merchant”, and the essential feature which enables the business paradigm to work is the referral hyperlink. That is, without the referral hyperlink or the existence of the “merchant”, the system or process of Bezos would not work. In combining Bezos with Goldschmitt, the Examiner essentially ignored the criticality of the function of the “merchant” and of the real function of the referral hyperlink of Bezos. In other words, the Examiner failed to consider the teaching of Bezos in its entirety in establishing a *prima facie* case of obviousness (MPEP 2141.02 p. 2100-122 Rev. 1, Feb. 2003).

Moreover, according to the Examiner, there is no distinction between a referral hyperlink and an advertisement in Bezos. According to page 12, lines 12-14, the Examiner clearly states that even the hyperlink displaying the product (i.e., Fig. 6, unit 600) is a form of advertisement that is under the control of the associate. The Examiner further stated that the associate’s reviews, editorial description, and recommendations all constitute a form of advertisement. The Examiner stated that anything that can be seen or heard is a form of advertisement.

In contrast with Bezos, claim 1 of the present invention clearly distinguishes a communication from an advertisement. As reiterated above, in order to distinguish a communication from an advertisement and to advance this application toward allowance, Applicant amended previously claims 1 and 20 to include the language “wherein said at least one advertisement optionally includes a hyperlink.” However, at this juncture, as the Examiner insists that the referral hyperlink and the associate’s testimonials, reviews, recommendations, and editorial reviews all constitute a form of advertisement in Bezos, Applicant has amended claims 1 and 20, as shown above, to delete the language “wherein said at least one advertisement optionally includes a hyperlink”, and Applicant has added new dependent claims 25 and 26, which depend from claims 1 and 20, respectively, to recited this feature and to thereby invoke the doctrine of claim differentiation. In re *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-72 (Fed. Circ. 1999), In re *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.* (381 F.3d 1111; 2004 U.S. App.).

The doctrine of claim differentiation means that limitations stated in dependent claims are not to be read into the independent claims from which they depend (In re *Karlin Tech*, supra). This interpretative tool stem from the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope.

In this instant amendment, dependent claim 25 and 26 clearly differentiate from the meanings and scope of independent claims 1 and 20, respectively. In other words, by separating the feature wherein the at least one advertisement includes a hyperlink, Applicant has clearly distinguished a hyperlink from an advertisement. That is, in Applicant’s claimed invention, referral hyperlinks are not themselves an advertisement, which is inherently different from the Examiner’s interpretation of the referral hyperlink of Bezos.

Again, in contrast with Applicant’s claimed feature, the Examiner interprets the referral hyperlink of Bezos as a form of advertisement. The Examiner also interprets

the Associate's reviews, recommendations, etc., as an advertisement. Hence, there is no differentiation between hyperlink and an advertisement, according to the Examiner. Incidentally, as the Examiner stated that everything can be an advertisement, including hyperlinks and Associate's reviews and comments recommending a product, the Examiner left no explanation for what in Bezos is equivalent to Applicant's claimed communication and what is an advertisement embedded in the communication.

Further, in spite of the fact that the feature of "wherein said at least one advertisement optionally includes a hyperlink" is deleted from claim 1 and 20, Applicant would like to note that the Examiner's assertion that the word "option" is a conditional limitation is incorrect. Applicant respectfully asserts that the word "optionally" is not conditional language as alleged by the Examiner in page 13, Section 7 of the detailed Office Action. The Examiner is invited to consult with a dictionary for the meaning of "optional" and with *In re Ex parte Cordova*, 10 PQ2d 1949 and *Ex parte Wu*, 10 PQ2d 2031. Nonetheless, as this feature is now recited in claims 25 and 26 with the doctrine of claim differentiation invoked, the word "optionally" is no longer needed and hence is not recited in claims 25 and 26.

The presently claimed invention is further distinguished from Goldschmitt and Bezos by the limitations in amended claim 3, for example. Claim 3 has been amended to further clarify the claim language. As amended, claim 3 recites that the advertisement is related to at least one of the software or hardware operable with the data processing system. The Examiner is respectfully directed to, e.g., page 13, lines 13-20 for support for this claimed feature. A preferred embodiment disclosed in the specification features a new mouse installation on a user's PC. During the installation of this new peripheral equipment, the user is given an opportunity to become an advertiser for the mouse. Should the user accept the offer to become an advertiser of this particular product, an advertisement related to the mouse would be embedded in e-mail communications of the user and sent to the recipients of the e-mail

communications. This process is illustrated in a flow diagram of Fig. 2. Applicant respectfully notes that the Examiner's reasoning for the rejection of claim 3 does not appear to relate to Applicant's claimed invention.

It is well settled that when combining the references in order to support a *prima facie* case of obviousness, the references must be considered in their entirety. It is further settled that the mere fact that the prior art may be modified to reflect features of the claimed invention does not make the modification and hence the claimed invention obvious unless the desirability of such modification is suggested by the prior art itself (MPEP §2141). Moreover, the claimed invention cannot be used as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious, *In re Fritsch*, 23 USPQ2d 1780 (Fed. Cir. 1992). As set forth above, Applicant respectfully submits that the application of Goldschmitt as the primary reference in the rejection of claims 1-19 and 23 and 24 is improper at least for the reason that there is no suggestion of motivation to combine an e-mail system wherein the sender has no control over an attachment of advertisements of Goldschmitt with an Internet commerce system, which involves interactions and a referral hyperlink to be passed between an "associate", a "customer" and a "merchant", of Bezos to arrive at Applicant's claimed invention.

As set forth above, Bezos' internet-based customer referral system is clearly different from the method of transmitting a communication including an advertisement of the presently claimed invention. The Examiner failed to provide motivation or suggestion of why and how one of ordinary skills in the art at the time the invention was made to combine the different teachings of an internet-based referral system of Bezos with an e-mail system of Goldschmitt.

With respect to the §103(a) rejection of independent claim 20 over Goldschmitt, Bezos and Uomini, Applicant respectfully submits that the arguments set forth above against the combination of Goldschmitt and Bezos are also applicable to

the rejection of claims 20 and 21. Moreover, the combination of Uomini is further improper at least for the reasons provided below.

Applicant respectfully directs the Examiner to the first paragraph of page 14 of Goldschmitt. It is specifically disclosed therein that advertisement attached to an electronic mail without interfering with the integrity of the message data contained within the electronic mail. Therefore, it would be contrary to the teaching of the primary reference to Goldschmitt to modify the information stored within the signature file to include at least one advertisement, as recited in Applicant's claim 20.

The Examiner asserted during the Interview of December 29, 2004 that the vCard being attached to an e-mail message as disclosed in Uomini encompasses Applicant's claimed step of modifying the information stored within the signature file to include an advertisement. However, Uomini merely discloses a system for adding to an electronic mail message context information regardless of whether or not the sender includes context information. Context information is information such as full name, address, telephone number, etc. The context information assists the receiver of electronic mail messages in identifying sender and/or where the electronic mail has originated.

Applicant respectfully submits that Uomini does not teach, disclose or suggest embedded advertisement, and that Uomini does not suggest or motivate modifying the information stored in the signature file to include an advertisement as recited in Applicant's claim 20. Further, as the Examiner interprets the vCard as an advertisement attached to an electronic mail message, and as the Examiner stated that anything that can be seen or heard is a form of advertisement, the Examiner is improperly stretching the meaning of advertisement beyond the scope of this instant invention as well as beyond the scope of the cited prior art references.

In view of the arguments set forth above, a *prima facie* case of obviousness has not been established by the combined teachings of Goldschmitt, Bezos and Uomini.

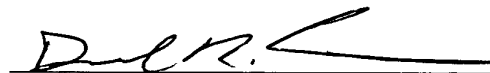
Consequently, the § 103(a) rejections of claims 20 and 21 are also not appropriate and must now be withdrawn.

In the interest of keeping prosecution history compact, and as the amendments and arguments set forth above with respect to all the independent claims are deemed sufficient to overcome all of the rejections, Applicant will not traverse each and every rejection of the dependent claims but reserves the right to do so in the future, as necessary.

In view of the arguments and amendments set forth above, the allowance of claims 1-24 and new claims 25-26 is respectfully requested.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with Applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Respectfully submitted,



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